



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/590,238

08/22/2006

Kenichi Iso

Q96682

6916

23373 7590 05/07/2009
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

05/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,238	Applicant(s) ISO, KENICHI	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 1-5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/22/06, 4/30/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 1-5 are objected to because of the following informalities: Claim 1 and its dependent claims recite "dynamic viscosity", but the viscosity is recited in the units used for kinematic viscosity. It is the examiner's opinion that applicant intends to claim the kinematic viscosity, and the claims have been treated in that manner in the rejections set forth below. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Takata (U.S. Pat. No. 6,020,290).

In column 2 lines 4-10, Takata discloses a grease composition for rolling bearings comprising a base oil and a urea thickener. In Tables 1-2, Examples 1 and 7, Takata discloses grease compositions containing a base oil having a viscosity of 45 cSt at 40° C, within the range recited in claim 1, and a urea thickener present in an amount (either 20% weight) within the range recited in claim 1, and an antirust agent present in an amount (3% by weight) within the range recited in claim 1. In column 6 lines 35-37,

Art Unit: 1797

Takata discloses that the antirust agent can be a sorbitan ester, meeting the limitations of the ester antirust agent of claim 1. The composition of Takata therefore meets the limitations of claim 1. The grease compositions of Takata further include zinc dithiocarbamates, meeting the limitations of claim 4. The application of the grease to rolling bearings, as taught by Takata, meets the limitations of claim 5.

In column 5 lines 24-30, Takata teaches that the urea thickener can be made by reacting a diisocyanate $\text{OCN-R}^{13}\text{-NCO}$ with two amines R^{12}NH_2 and R^{14}NH_2 . In column 4 lines 45-57 Takata discloses that the R^{13} group preferably has a structure meeting the limitations of the R_2 group of claim 3. In column 5 lines 22-24 Takata discloses that preferred R^{12} and R^{14} groups include cyclohexyl and octadecyl groups. When one of R^{12} or R^{14} is a cyclohexyl and the other is octadecyl, they meet the limitations of R_1 and R_3 of claim 3, and the urea thickeners of Takata will meet the limitations of claim 3. In several of the examples, Takata discloses that the thickener can be made from a mixture of cyclohexylamine and stearylamine, meeting the limitations of claim 3.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1797

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takata in view of Iso (U.S. PG Pub. No. 2002/0082175).

The discussion of Takata in paragraph 3 above is incorporated here by reference. Takata discloses a urea grease for a rolling bearing meeting the limitations of claim 1, but does not disclose the specific antirust agents recited in claim 2.

Iso, in paragraph 1, discloses rolling bearings packed with a grease having good rust-preventive performance. In Table 1 Iso discloses that the greases can be urea greases with base oils having viscosities similar to those of Takata, and further containing naphthenate and/or succinic acid derivative rust preventives. The rust preventives are further discussed in paragraphs 19-27. The use of the rust preventives of Iso as the antirust agents in the greases of Takata meets the limitations of claim 2.

It would have been obvious to one of ordinary skill in the art to include the naphthenate and/or succinic acid derivatives of Iso in the composition of Takata, as Iso teaches that the additives give superior rust-preventing performance.

Conclusion

Art Unit: 1797

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797